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Paper No. 10

Michael A. Diener
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In re Application of: Abramson et al.)
Application No.: 09/209,015)
Filed: December 10, 1998)
For: SYSTEM AND METHOD FOR)
AUTOMATIC MAPPING OF HYPERTEXT)
INPUT FIELDS TO SOFTWARE)
COMPONENTS)
)

**DECISION ON PETITION TO
ACCEPT CORRESPONDENCE AS
TIMELY FILED UNDER 37 CFR
§1.8(b)**

This decision is in response to the communication filed January 17, 2003, requesting withdrawal of the holding of abandonment. The request is being treated as a petition under 37 CFR §1.8(b) to accept correspondence as timely filed.

This application was held abandoned for failure to file a response in a timely manner to the Office action mailed on April 19, 2002 (Paper No. 6). A Notice of Abandonment was mailed on October 21, 2002 (Paper No. 7).

Issues

In support of the petition, Mr. Michael Diener has provided the following: (1) a statement by Mr. Diener, the attorney of record, that refers to the facsimile transmission of a Notice of Appeal with extension of time and fee on October 18, 2002, (with the Notice of Appeal containing the incorrect notation of October 18, 2001), (2) a copy of the Notice of Appeal, petition for extension of time and certificate of facsimile transmission; and (3) a supplemental statement from Ms. Jody Begley, filed on February 4, 2003, personally attesting to the facsimile transmission on October 18, 2002. Petitioners also provided a copy of the sender's transmittal report showing three (3) pages were transmitted to (703) 746-7239 on October 18, 2002. Ms. Begley's statement was requested via a telephone request because the certificate of facsimile transmission for the October 18, 2002 papers omitted any reference to the application number for which the papers were being filed and to satisfy the condition of the personal knowledge statement of the transmission necessary under 37 CFR § 1.8(b).

Mr. Diener makes reference in his petition to a “statutory time period of six months” being set in the Office action of April 19, 2002 and “the PALM system shows that an abandonment was entered October 18, 2002, before the due date.”

Decision

While petitioners state the abandonment was entered before the due date, in fact the mailing date of the Notice of Abandonment was October 21, 2002. The copy of the Notice of Abandonment provided by petitioners omits the cover page which included applicants’ address and mailing date of October 21, 2002. In addition it should be noted, the final rejection mailed April 19, 2002 set a shortened statutory period of three months. Therefore, absent receipt of any papers or petitions for extension of time, the application was in fact abandoned on July 19, 2002. Therefore, Mr. Diener’s remarks regarding the premature nature of the mailing of the Notice of Abandonment are without merit.

In regards to petitioners’ original submission. The papers provided did not fully comply with 37 CFR § 1.8. The format for the certificate of transmission did not comply with the guidelines set forth in MPEP § 512, “Procedure by Applicant.” Specifically, the certification filed on October 18, 2002 did not appear on the papers being submitted (the Notice of Appeal or the Extension of Time Request). The separate sheet failed to fully identify the application number and filing date of the application. In addition, petitioners did not provide a copy of the Office “Auto Reply Facsimile Transmission” which should be generated on all official faxes received successfully in the Office. Such proof would have served as *prima facie* evidence of receipt of the item in the USPTO – parallel to the treatment of the return post card practice for mailed correspondence. (See USPTO web site notice, “Patent Customers Advised to FAX Communications to USPTO” dated November 2, 2001.) A search of the database for faxes received in the Technology Center for the period of time in question did not reveal the receipt of applicants’ submissions. Therefore, applicants’ correspondence could not be held to be timely filed under 37 CFR § 1.8(a).

In considering petitioners’ submission under 37 CFR § 1.8(b), the correspondence can be considered timely filed if petitioners meet at least three conditions:

- (1) Informs the Office of the previous mailing or transmission of the correspondence **promptly** after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit’s report confirming transmission may be used to support this statement.

[Emphasis added.]

The petitioners’ evidence with supplement establishes that a timely response was, in fact, filed in response to the Office action of April 19, 2002 (Paper No. 6) on October 18, 2002. However, because the petition was filed more than two months after the mail date of the Notice of

Abandonment, the petition is being dismissed as being untimely under 37 CFR § 1.8(b)(1) and § 1.181(f). 37 CFR § 1.181(f) states:

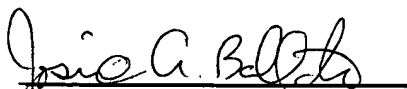
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 711.03(c) suggests the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that a terminal disclaimer accompanies the petition. Therefore, a terminal disclaimer accompanied by appropriate fee is required in compliance with 37 CFR § 1.181(f) and MPEP 711.03(c).

Mr. Diener was notified on February 19 and 20, 2003 that the filing of a terminal disclaimer with appropriate fee would resolve the issue of the filing of an untimely petition, but he declined to submit the necessary paperwork due to his position that the all papers were in fact timely filed and that the application was not properly abandoned.

Therefore, the petition is **DISMISSED** as untimely. In the event that petitioners submit the terminal disclaimer and fee, applicants are advised the period for reply will continue to run from the filing date of the Notice of Appeal which was October 18, 2002.

Any inquiries related to this decision should be directed to the undersigned at (703) 308-0269.



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